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09/833,148	04/11/2001	Yusuke Kimata	P/2850-48	1646
7590 02/27/2007 STEVEN I. WEISBURD DICKSTEIN SHAPRIO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS 41ST FLOOR NEW YORK, NY 10036-2714			EXAMINER GLASS, RUSSELL S	
			ART UNIT 3626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/833,148	Applicant(s) KIMATA, YUSUKE	
	Examiner Russell S. Glass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 2, 3, 11, 12, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud, (U.S. 5,845,255).**

3. As per claim 2, Mayaud teaches a method for sharing information of an individual that uses a network system in which a plurality of hospital terminals, a plurality of user terminals, and a database terminal for managing a database of information of an individual are mutually connected via a communication network, wherein:

- (a) a hospital acquires a hospital ID and a hospital password, (Mayaud, col. 18, line 56),

- (b) a user who is a patient or a person who takes care of welfare of the patient acquires a user ID, a user password, a second password, and space for storing information concerning medical treatment of an individual in a database, (Mayaud, Abstract, col. 10, lines 41, 44; col. 9, lines 1-3)(disclosing a physician user and privacy

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controls for patient and doctor, wherein a physician is a person who takes care of the welfare of the patient)., and

(c) a hospital acquires individual medical treatment information from the database using the user ID, the second password, the hospital ID, and the hospital password as keys, and stores updated individual medical treatment information in the database using the user ID, the second password, the hospital ID, and the hospital password as keys, (Mayaud, col. 10, lines 41, 44; col. 17, lines 40-54; col. 49, line 41).

Mayaud fails to expressly disclose a using all four keys at the same time to access data. However, Mayaud teaches that data access control can be realized through the compound use of standard identifiers or keys such as names, passwords, or unique identifiers such as alphanumeric codes, social security numbers, or the like. Mayaud further discloses that can be used alone or in sequence with one another to achieve the desired security level and to avoid confusing the files of persons with similar names. (Mayaud, col. 10, lines 41, 44; col. 17, lines 40-60). Additionally, Mayaud teaches that individuals and organizations can be given patient-defined selective access through patient-generated record-access specifications, (Mayaud, col. 18, lines 6-23).

Examiner considers this method in Mayaud to be closely analogous to the method in claim 2. Therefore, in light of Mayaud, it would be obvious to one of ordinary skill in the art to modify Mayaud to use multiple user and hospital I.D.'s and passwords as data keys. The motivation would be to prevent unauthorized access, (Mayaud, col. 17, lines 27-28).

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4. As per claim 3, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2, wherein the user views individual medical treatment information on the database using the user ID and the user password as keys (Mayaud, col. 10, lines 41, 44; col. 17, lines 27-28; col. 46, lines 41-44).

Mayaud teaches that the data-access control software is accessed by patients with data-access rights. The patient terminals are separate from the physician terminals. This is considered to be analogous to the user viewing individual medical treatment information on the database using the user ID and the user password as keys.

Examiner considers this method in Mayaud to be analogous to the method in claim 2. In light of Mayaud, it would be obvious to one of ordinary skill in the art for a user to view individual treatment information on a database using I.D.'s and passwords as data keys. The motivation would be to prevent unauthorized access, (Mayaud, col. 17, lines 27-28).

5. As per claim 11, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2, wherein the user specifies a hospital and restricts access by the specified hospital to the space where the individual medical treatment information of the user is stored using the user I.D. and the user password as keys, (Mayaud, col. 10, lines 41, 44; col. 17, lines 27-28; col. 46, lines 41-44; col. 18, lines 6-23).

Mayaud teaches that the data-access control software is controlled by patients with data-access rights. The patients have the ability to control the access of organizations to stored patient records through the use of passwords, social security numbers, and alphanumeric codes.

Examiner considers this method in Mayaud to be analogous to the method in claim 11. In light of Mayaud, it would be obvious to one of ordinary skill in the art for a user to user specifies a hospital and restricts access by the specified hospital to the space where the individual medical treatment information of the user is stored using the user I.D. and the user password as keys. The motivation would be to prevent unauthorized access of organizations such as hospitals, (Mayaud, col. 17, lines 27-28).

6. As per claim 12, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2, wherein, a cooperating company terminal that is used by a cooperating company that is in cooperation with whoever is managing the database is incorporated into the network system and, using this network system, the cooperating company acquires a cooperating company ID and cooperating company password and, after the user has given permission for the individual medical treatment information to be made available to the cooperating company using the user ID and user password as keys, the cooperating company acquires the individual medical treatment information of the user from the database using the cooperating company ID and cooperating company password as keys,

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(Mayaud, col. 10, lines 41, 44; col. 17, lines 27-28; col. 46, lines 41-44; col. 18, lines 6-23).

Mayaud teaches that the data-access control software is controlled by patients with data-access rights. The patients have the ability to control the access of organizations to stored patient records through the use of passwords, social security numbers, and alphanumeric codes.

Examiner considers this method in Mayaud to be analogous to the method in claim 12. In light of Mayaud, it would be obvious to one of ordinary skill in the art for a user to give permission for the user's individual medical treatment information to be made available to a cooperating company using the user ID and user password as keys, the cooperating company acquires the individual medical treatment information of the user from the database using the cooperating company ID and cooperating company password as keys. The motivation would be to prevent unauthorized access of organizations such as cooperating companies, (Mayaud, col. 17, lines 27-28).

7. As per claim 16, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2, wherein the database terminal receives a request sent from the hospital terminal or from the cooperating company terminal for the individual medical treatment information of the user to be made available and transfers the request to the user terminal of the user, and also receives an approval from the user terminal regarding the request for the individual medical treatment information to be made available, (Mayaud, col. 10, lines 12-66; col. 17, lines

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40-54; col. 18, lines 6-23; col. 50, lines 48-54)(providing the patient with the ability to predetermine access to their own data).

Examiner considers this method in Mayaud to be analogous to the method in claim 16. In light of Mayaud, the method for sharing information concerning medical treatment of an individual, wherein the database terminal receives a request sent from the hospital terminal or from the cooperating company terminal for the individual medical treatment information of the user to be made available and transfers the request to the user terminal of the user, and also receives an approval from the user terminal regarding the request for the individual medical treatment information to be made available would be obvious to one of ordinary skill in the art. The motivation would be to allow the user to prevent unauthorized access of organizations such as cooperating companies, (Mayaud, col. 17, lines 27-28).

8. Claims 4-6, 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud as applied to claims 2, 3, 11 and 12 above, and further in view of Nelson et al., (U.S. 6,564,104).

9. As per claim 4, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2. However, Mayaud fails to teach a method for sharing information wherein a charge is levied on the hospital when the hospital acquires individual medical treatment information from the database.

Nelson teaches a medical communications system for sharing information concerning medical treatment, wherein a charge is levied on the hospital when the hospital acquires individual medical treatment information from the database, (Nelson, col. 16, lines 46-49) (providing the system to a clinical entity on a fee per use or per data access basis is considered to be analogous to the method in claim 4 where the data is acquired).

It would be obvious to one of ordinary skill in the art to combine Nelson with Mayaud. The motivation would have been to provide a vital system and method of delivering efficient therapy and clinical care to the patient, (Nelson, col. 6, lines 22-25).

10. As per claim 5, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2. However, Mayaud fails to teach a method for sharing information wherein a charge is levied on the hospital when the hospital saves updated individual medical treatment information from the database.

Nelson teaches a medical communications system for sharing information concerning medical treatment, wherein a charge is levied on the hospital when the hospital saves updated individual medical treatment information from the database, (Nelson, col. 16, lines 46-49) (providing the system to a clinical entity on a fee per use or per data access basis is considered to be analogous to the method in claim 4 where the data is saved).

It would be obvious to one of ordinary skill in the art to combine Nelson with Mayaud. The motivation would have been to provide a vital system and method of delivering efficient therapy and clinical care to the patient, (Nelson, col. 6, lines 22-25).

11. As per claim 6, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 3. However, Mayaud fails to teach a method for sharing information wherein a charge is levied on the user when the user views individual medical treatment information.

Nelson teaches a medical communications system for sharing information concerning medical treatment, wherein a charge is levied on the user when the user views individual medical treatment information, (Nelson, col. 16, lines 46-49) (providing the system to a host patient on a fee per use or per data access basis is considered to be analogous to the method in claim 5 where the user views data).

It would be obvious to one of ordinary skill in the art to combine Nelson with Mayaud. The motivation would have been to provide a vital system and method of delivering efficient therapy and clinical care to the patient, (Nelson, col. 6, lines 22-25).

12. As per claim 13, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 12. However, Mayaud fails to teach a method for sharing information wherein a charge is levied on the cooperating company when the cooperating company acquires individual medical treatment information from the database.

Nelson suggests a medical communications system for sharing information concerning medical treatment, information wherein a charge is levied on the cooperating company when the cooperating company acquires individual medical treatment information from the database, (Nelson, col. 16, lines 46-49) (providing the system to a host patient or a clinician or a clinical entity on a subscription basis, on a fee per use, or per data access basis is considered to be analogous to the method in claim 5 where the cooperating company acquires data).

It would be obvious to one of ordinary skill in the art to combine Nelson with Mayaud in order to provide information to third parties such as cooperating companies. The motivation would be to provide a high efficiency communications system to enhance data communications, (Nelson, col. 4, lines 37-39).

13. Claims 7, 8, 17, 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud in view of Anderl et al, (U.S. 4,882,474).

14. As per claim 7, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2. However, Mayaud fails to teach a method for sharing information concerning medical treatment of an individual, wherein the user password is altered using the user ID and the user password as keys.

Anderl suggests a method wherein the user password is altered using the user ID and the user password as keys, (Anderl, col. 7, lines 61-68; col. 8, lines 4-10). In

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Anderl, a login command and password is entered before the user is allowed to change a password. A login command is considered to be analogous to the entry of a user I.D.

It would be obvious to one of ordinary skill in the art to combine Anderl with Mayaud. The motivation would have been to provide security protection for the system and allow for flexibility, (Anderl, col. 2, lines 17-20).

15. As per claim 8, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2. However, Mayaud fails to teach a method for sharing information concerning medical treatment of an individual, wherein second password is altered using the user ID and the user password as keys.

Anderl suggests a method wherein a second password is altered using the user ID and the user password as keys, (Anderl, col. 7, lines 61-68; col. 8, lines 4-10). In Anderl, a login command and password is entered before the user is allowed to change a password. A login command is considered to be analogous to the entry of a user I.D. Additionally, Anderl teaches that multiple passwords may be used to achieve higher levels of security, (Anderl, col. 2, lines 3-9).

It would be obvious to one of ordinary skill in the art to combine Anderl with Mayaud. The motivation would have been to provide security protection for the system and allow for flexibility, (Nelson, col. 2, lines 17-20).

16. As per claim 17, Anderl suggests a computer-readable medium encoded with:
(a) a database containing information of an individual, (Anderl, col. 2, lines 3-9);

- (b) a computer program for sending a user password and a second password to a user terminal, (Anderl, col. 2, lines 3-9); and
- (c) a computer program that requests the second password when a person other than the user accesses the space where the individual information is stored, (Anderl, col. 5, lines 1-5, 30-67; col. 6, lines 19-21).

Anderl fails to disclose that the user is a person who takes care of the welfare of the patient. However, Mayaud teaches a method for sharing medical treatment information of an individual over a communication network by a physician, (Mayaud, Abstract)(a physician is a person who takes care of the welfare of the patient).

It would be obvious to one of ordinary skill in the art to combine Anderl with Mayaud. The motivation would have been to provide security protection for the system and allow for flexibility, (Anderl, col. 2, lines 17-20).

17. As per claim 18, Anderl suggests the computer readable medium according to claim 17, further encoded with a computer program for requesting the user password when the second password is altered, (Anderl, col. 8, lines 4-10)(requiring that a password be given for a password to be changed).

Anderl fails to disclose that the information is medical treatment information. However, Mayaud teaches a method for sharing prescription information of an individual over a communication network. Prescription information is considered to be analogous to medical treatment information. (Mayaud, Abstract).

It would be obvious to one of ordinary skill in the art to combine Anderl with Mayaud. The motivation would have been to provide security protection for the system and allow for flexibility, (Anderl, col. 2, lines 17-20).

18. Claims 9, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud as applied to claim 2 above, in view of Engleson et al., (U.S. 5,781,442).

19. As per claim 9, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2. However, Mayaud fails to teach a method, wherein, if updated individual medical treatment information is not saved in the database within a predetermined time after the hospital has acquired the individual medical treatment information from the database, notification is sent to the hospital requesting updated individual medical treatment information.

Engleson suggests a method, wherein, if updated individual medical treatment information is not saved in the database within a predetermined time after the hospital has acquired the individual medical treatment information from the database, notification is sent to the hospital requesting updated individual medical treatment information.

The methods disclosed in Engleson teach that a remote terminal near a patient receives medical treatment information, such as a treatment plan parameter. Then, if updated medical information regarding the planned administration of drugs or medical treatment is not transmitted from the remote terminal within a certain predetermined

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period, an alarm is activated to notify hospital staff to perform the treatment protocol.

The facts regarding the recent treatment are then recorded, thus updating the individual medical treatment information in the database, (Engleson, Abstract; col. 1, lines 29-35; col. 4, lines 50-63; col. 6, lines 41-51; col. 8, lines 54-65; col. 9, lines 20-26; col. 10, lines 12-14; col. 11, lines 16-23).

It would be obvious to one of ordinary skill in the art to combine the teaching of Mayaud and Engleson to arrive at the method in claim 9. The motivation would be to integrate patient care information with other institutional databases to achieve a reliable, efficient, and cost-effective delivery of health care to patients (Engleson; col 2, lines 15-21).

20. As per claim 14, Mayaud suggests the method for sharing information concerning medical treatment of an individual according to claim 2. However, Mayaud fails to teach a method for sharing information concerning medical treatment of an individual according to claim 2, wherein treatment costs are included in the individual medical treatment information.

Nelson suggests a method wherein treatment costs are included in the individual medical treatment information, (Engleson, col. 1, lines 36-42; col. 2, line 17; col. 10, lines 64-67).

It would be obvious to one of ordinary skill in the art to combine the teaching of Mayaud and Engleson to arrive at the method in claim 14. The motivation would be to more fully capture billing opportunities (Engleson; col 1, lines 36-42).

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21. As per claim 15, Mayaud suggests the method for sharing information concerning medical treatment of an individual using the user ID and user password as keys.

However, Mayaud fails to teach a method wherein the user is issued with a treatment cost report calculated from the treatment costs on the database.

Engleson suggests a method wherein the user is issued with a treatment cost report calculated from the treatment costs on the database, (Engleson, col. 1, lines 36-42; col. 2, line 17; col. 10, lines 64-67).

It would be obvious to one of ordinary skill in the art to combine the teaching of Mayaud and Engleson to arrive at the method in claim 15. The motivation would be to more fully capture billing opportunities (Engleson; col 1, lines 36-42).

22. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud in view of Engleson as applied to claim 9 above, and further in view of Nelson.

23. As per claim 10, Mayaud and Engleson suggest a method for sharing information concerning medical treatment of an individual. However, they do not clearly provide a method wherein notification of the updating of the individual medical treatment information is sent to the user when updated individual medical treatment information is saved in the database.

Nelson provides a method wherein notification of the updating of the individual medical treatment information is sent to the user when updated individual medical treatment information is saved in the database, (Nelson, col. 15, lines 47-61).

It would be obvious to one of ordinary skill in the art to combine Nelson with the collective system of Mayaud and Engleson. The motivation would have been to provide a high efficiency communications system to enhance data communications. (Nelson, col. 4, lines 37-39).

Response to Arguments

Applicant's arguments filed on December 12, 2006 have been fully considered but they are not persuasive for the following reasons:

1. As per Applicant's assertion that Mayaud fails to suggest using a four key combination comprising "the user I.D., the second password, the hospital I.D. and the hospital password as keys" for a hospital to update and store updated individual and medical information, it is submitted that the passages cited in Mayaud do in fact disclose user access to a database, provided they have the right passwords. These passages further disclose using coded alphanumeric patient identifiers, and user I.D.'s to update and acquire data. Therefore, the Mayaud reference is clearly suggestive of, and renders obvious the limitation of claim 2 which is considered to consist of a mere duplication of the passwords disclosed by Mayaud. It has been held that mere duplication of parts has no patentable significance unless a new and unexpected result

is produced, (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)(see also MPEP 2144.04). Here, the result produced is patient-controlled access of personal medical records, which is not considered to be new and unexpected in view of Mayaud.

Furthermore, Mayaud teaches a system and method wherein both a physician-user and a hospital using the system wherein each would be required to use multiple privacy control passwords, (Mayaud, Abstract, col. 15, lines 4-30; col. 16, lines 23-38).

2. As per applicant's argument that Anderl fails to disclose a computer program that requests a second password when a person other than a user accesses the space where the individual medical treatment information is stored, it is submitted that Anderl discloses such a limitation. As admitted by Applicant, Anderl requires a second password from a user in order to access patient information in a progressively higher security area, (Anderl, fig. 2; col. 5, lines 30-67). Anderl discloses using a hierarchy of passwords to reach progressively more secure data and functions, wherein at least a second password is requested.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2/7/2007

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